REMARKS

By this amendment, claims 1, 3, 7-12, 14, 17, 21-23, 27-30, 32-35, and 37-41 are pending, in which claims 16, 18-20, 24-26, and 31 were previously canceled without prejudice or disclaimer, claims 2, 4-6, 13, 15, and 36 are currently canceled without prejudice or disclaimer, claims 37-39 stand withdrawn from consideration pursuant to the provisions of 35 U.S.C. § 121, claims 1, 3, 11, 12, 17, 21, 23, 35, and 40 are currently amended. No new matter is introduced.

The Office Action mailed March 19, 2010 objected to claims 11, 17, and 23 for being improper dependent claims, and rejected claims 1, 12, 21, 27, 35, 36, and 40 under the first paragraph of 35 U.S.C. §112 as being based on an inadequate written description, claims 1-15, 17, 21-23, 40, and 41 under 35 U.S.C. §101 as being non-statutory, claims 1-26, 35, and 36[1] as obvious under 35 U.S.C. §103(a) based on *Leonard* (US 6,085,171) in view of *Bednarek* (US 6,965,868), claims 27-30 and 32-34 as obvious under 35 U.S.C. §103(a) based on *Leonard* (US 6,085,171) and *Bednarek* (US 6,965,868) in view of *Sridhar et al.* (US 6,098,108), and claims 40 and 41 as obvious under 35 U.S.C. §103(a) based on *Leonard* (US 6,085,171) in view of *Bansal* (US 6,788,949).

Applicants wish to thank Examiner Marissa Thein for the telephonic interview on June 3, 2010, at which time the subject invention was explained in light of Applicants' disclosure, the outstanding issues were discussed, and arguments substantially as hereinafter developed were presented. Applicants' attorney pointed out features relating to support for "customer who is not yet a subscriber" at paragraphs [07]-[14] of the specification, and to "pre-sale procurement inquiries," which is not taught or suggested by the applied references. The Examiner indicated that she would consider the proposed amendments and arguments relative to the objection of

[1] It is apparent that Examiner intended only claims 1-15, 17, 21-23, 35, and 36, since claims 16, 18-20, and 24-26 are canceled claims.

claims 11, 17, and 23, and the rejections under 35 U.S.C. §§ 101, 103, and 112. However, no formal agreement was reached, pending the Examiner's detailed reconsideration of the application upon formal submission of a response to the outstanding Office Action.

The objection to claims 11, 17, and 23 is traversed. These claims have now been clarified to depend from the methods recited in their respective independent claims by reciting that the steps recited in those independent claims are "performed in accordance with executable instructions stored in computer readable media."

Accordingly, the Examiner is respectfully requested to withdraw the objection to claims 11, 17, and 23.

The rejection of claims 1, 12, 21, 27, 35, 36, and 40 under the first paragraph of 35 U.S.C. §112 is traversed.

The Examiner asserted that the claim feature "a customer who is not yet a subscriber" is new matter lacking support in the original disclosure, in addition to being a "negative limitation." Applicants respectfully disagree.

The inquiry to be made regarding a rejection under the written description clause of 35 U.S.C. §112, first paragraph, pertains to whether the disclosure (specification, drawings, claims) as originally filed reasonably conveys to the journeyman practitioner in the art that the inventor had possession at that time of that which he now claims. *In re Wertheim,* 541 F.2d 257, 191 USPQ 90, 98 (CCPA 1976). Literal support of the disclosure for the terms of the claims challenged by the examiner is not necessary in order to show such possession. *In re Wright*, 866 F.2d 422, 425, 9 USPQ2d 1649, 1651 (Fed. Cir. 1989); *In re Kaslow*, 707 F.2d 1366, 1375,

217 USPQ 1089, 1096 (Fed. Cir. 1983); *In re Herschler*, 591 F.2d 693, 700-701, 200 USPQ 711, 717 (CCPA 1979); *In re Lukach,* 442 F.2d 967, 969, 169 USPQ 795, 796 (CCPA 1971).

It is clear, from paragraphs [07] through [17], for example, that Applicants had possession of that which is now claimed, i.e., "a customer who is not yet a subscriber." In paragraph [07], for example, it is stated, "The system provides **a new customer** experience for pre-sale, order processing, and post-sale support. For pre-sale services, **a prospective customer** links to the site of, for example, a proprietary telecommunications service provider… Once **the prospective customer** has determined the services appropriate to his/her business and the system has qualified them, they may enter a Shopping Cart/Service Ordering section of the site, select their services, and click on, for example, an "Order Now" button to proceed." Clearly, such teachings provide adequate support for the claim feature of "a customer who is not yet a subscriber" since a "prospective customer" is "a customer who is not yet a subscriber."

With regard to the assertion in the Office Action that the claim feature is a "negative limitation," Applicants note that negative limitations, *per se*, are not fatal to claimed subject matter so long as there is proper support for the "negative limitation," *Ex parte Grasselli*, 231 USPQ 393 (Bd. App. 1983), aff'd mem, 738 F.2d 453 (Fed. Cir. 1984). As previously argued, paragraphs [07] through [17] of the specification, for example, provide for such proper support in the instant case.

In any event, the claim feature of "a customer who is not yet a subscriber" is not a "negative limitation." Rather, it is a positive recitation of a prospective subscriber. There are two types of customers, i.e., those who are already subscribers to a service and those who are prospective subscribers to the service. The claim feature of "a customer who is not yet a subscriber" merely positively describes the latter.

Accordingly, the Examiner is respectfully requested to withdraw the rejection of claims 1, 12, 21, 27, 35, 36, and 40 under the first paragraph of 35 U.S.C. §112.

The rejection of claims 1-15, 17, 21-23, 40, and 41 under 35 U.S.C. §101 is traversed.

To advance prosecution and reduce issues for potential appeal, Applicants have amended independent claims 1, 12, 21, and 40 to positively recite that the claimed computer-implemented method for procuring telecommunications offerings includes a computer program configured to control **at least one processor**, and that the **at least one processor** is recited in the body of the claims as being responsible for performing or implementing each of the claimed steps. Since each and every claimed step is now positively tied to "at least one processor" for performing the claimed step, and it is clear that "at least one processor" is a recitation of a specific "machine," the "machine-transformation" test of *In re Bilski*, 544 F.3d 943, 88USPQ2d 1385 (Fed. Cir. 2008) has been satisfied.

Accordingly, the Examiner is respectfully requested to withdraw the rejection of claims 1-15, 17, 21-23, 40, and 41 under 35 U.S.C. §101.

The rejection of claims 1-26, 35, and 36 under 35 U.S.C. §103(a) is traversed.

As amended, independent claim 1 recites, *inter alia*, "receiving, via the at least one processor, a **pre-sale** procurement inquiry from a customer application, the **pre-sale** procurement inquiry specifying a selected telecommunications offering from a plurality of offerings...." Independent claim 12 now recites, *inter alia*, "receiving, via the at least one processor, a **pre-sale** inquiry from a customer application, the **pre-sale** inquiry specifying a search criteria with respect to an order for one of a plurality of telecommunications offerings...." Independent claim 21

now recites, *inter alia*, "submitting, via the at least one processor, a **pre-sale** inquiry specifying a selected telecommunications offering from among a voice service offering, a data access offering and a mobile telecommunications offering, the **pre-sale** inquiry being directed at least to telecommunication services to which a customer who is not yet a subscriber is considering a subscription." Independent claim 35 recites, *inter alia*, "means for receiving a **pre-sale** procurement inquiry from a customer application, the **pre-sale** procurement inquiry specifying a selected telecommunications offering including voice service, data access service and mobile telecommunications service, the **pre-sale** procurement inquiry being directed at least to one or more telecommunication services to which a customer who is not yet a subscriber is considering a subscription."

Independent claim 36 has been canceled.

Thus, each of independent claims 1, 12, 21, and 35 recites that the inquiry, or procurement inquiry relates only to "pre-sale" procurement inquiries. In contrast, *Leonard* is directed only to processing orders of current service provider customers who are changing communication services. Thus, in *Leonard*, there is no disclosure or suggestion of a prospective subscriber, or one who is not yet a subscriber, making a pre-sale procurement inquiry as to what offerings are available. Rather, in *Leonard*, the customer already knows, or does not care, exactly what offerings are available from the new service provider, or communication service, and there is no pre-sale procurement inquiry regarding such offerings. In *Leonard*, there is only a communication service change order, which needs to be processed. *Bednarek*, employed for the supposed teaching of providing an option for accessing a network consultant via instant messaging, does not cure the deficiencies of *Leonard*.

Therefore, for this reason alone, no *prima facie* case of obviousness has been established with regard to the subject matter of claims 1, 3, 7-12, 14, 16-26, and 35.

Moreover, each of independent claims 1, 12, 21, and 35 recites "providing, via the at least one processor, an **option for accessing a network consultant via instant messaging**," or similar features in varying scope. As acknowledged in the Office Action, *Leonard* discloses no such feature. *Bednarek*, employed for this supposed teaching, does, indeed, teach providing access to a network consultant via instant messaging. However, it appears that in *Bednarek*, accessing a network consultant is not an "option," as claimed. Rather, *Bednarek* always provides for the network consultant. For example, at col. 11, lines 64-66, of *Bednarek*, it is recited, "A customer and sales agent **then engage in** real time dialogue either through video conferencing, **instant messaging**, of voice over the Internet." But just prior to that recitation, *Bednarek* discloses that "a customer can enter the vetail [sic] website and **select either** a **category product or particular sales agent** to deal with"; it appears that the Examiner interprets the fact that a selection between a product or an agent to be an option in the context of the claims. However, in the next line, *Bednarek* states, "If the customer selects a particular category of goods, they must select either their sales agent of the first available sales agent." Thus, the customer in *Bednarek* must always communicate with a sales agent because if the customer selects a particular sales agent to deal with, the customer deals with that agent. But if the customer selects a category product, this selection leads to a selection of "either their sales agent of the first available sales agent"; that is, another sales agent may be used. Accordingly, there is in fact no option to access a sales agent, as ultimately a sales agent is always accessed. Therefore, unlike the claimed subject matter, neither *Bednarek* nor *Leonard* provides for an **option** to access "**a network consultant via instant messaging**," If *Bednarek* always provides

for a communication with a sales agent, then, clearly, the customer is not given the **option to access or to not access** that sales agent.

Thus, the Examiner is respectfully requested to withdraw the rejection of claims 1, 3, 7-12, 14, 16-26, and 35 under 35 U.S.C. §103(a).

The rejection of claims 27-30 and 32-34 under 35 U.S.C. §103(a) is traversed.

Independent claim 27 not only recites "the procurement inquiry being directed at least to one or more telecommunication services to which a **customer who is not yet a subscriber** is considering a subscription," which distinguishes over the art of record for the reason previously argued, *viz.,* customers in the applied references are already subscribers to the service, but the claim also recites the specifics of "a customer browser loaded on a customer client computer," "a back office browser loaded on a back office client computer," and "a server program loaded on a server computer and being configured to receive the procurement and service inquiries."

The Office Action acknowledged that neither *Leonard* nor *Bednarek* discloses these features, or the features of a web layer, an application layer, a database layer, a site intelligence server, and a development, staging and production system. The Office Action relied on *Sridhar et al.* for these features. While Applicants do not agree that *Sridhar et al.* teaches each and every one of these claimed features, even if it assumed, *arguendo*, that all of these features are suggested by *Sridhar et al.*, there would have been no reason to combine the references in such a manner as to result in the instant claimed subject matter.

Each of the claimed features of "a customer browser loaded on a customer client computer," "a back office browser loaded on a back office client computer," and "a server program loaded on a server computer" serves a very specific function. For example, the

customer browser is "configured to submit a procurement inquiry specifying a selected telecommunications offering;" the back office browser is "configured to submit a service inquiry specifying a search criteria with respect to an order for a telecommunications offering," and the server program is "configured to receive the procurement and service inquiries." There are no elements within *Sridhar et al.* that serve these functions because *Sridhar et al.* is not concerned with procurement inquiries for specifying telecommunication offerings. Thus, to whatever extent *Sridhar et al.* may even be considered as suggesting "a customer browser loaded on a customer client computer," "a back office browser loaded on a back office client computer," and "a server program loaded on a server computer," which it does not, none of those supposed elements serves the claimed functions of submitting a procurement inquiry specifying a selected telecommunications offering, submitting a service inquiry specifying a search criteria with respect to an order for a telecommunications offering, and/or receiving the procurement and service inquiries. Thus, the rationale presented in the Office Action for making the proposed combination can only be based on impermissible hindsight gleaned from Applicants' disclosure. This is not a proper basis on which to conclude obviousness.

Accordingly, the Examiner is respectfully requested to withdraw the rejection of claims 27-30 and 32-34 under 35 U.S.C. §103(a).

The rejection of claims 40 and 41 under 35 U.S.C. §103(a) is traversed.

Independent claim 40 recites, *inter alia*, "providing, via the at least one processor, a **plurality of options to communicate with a consultant** during the provisioning, wherein the options include instant messaging and on-line shared white-boarding, wherein the option is displayed via a customer application to a user, the provisioning including at least a **pre-sale**

inquiry directed at least to one or **more telecommunication services to which a customer who is not yet a subscriber is considering a subscription**."

For the reasons previously argued, *Leonard* does not disclose or suggest a "pre-sale inquiry" as the inquiries in *Leonard* are directed to pending orders. Moreover, for reasons previously argued, *Leonard* does not provide for the claimed "options to communicate with a consultant."

The Office Action relied on *Bansal* for the supposed teaching of instant messaging and on-line shared white-boarding, as well as a web interface.

To whatever extent *Bansal* may suggest white-boarding, it still does not cure the deficiencies of *Leonard* in failing to disclose or suggest a "pre-sale inquiry." Accordingly, no *prima facie* case of obviousness has been established with regard to the subject matter of claims 40 and 41.

Thus, the Examiner is respectfully requested to withdraw the rejection of claims 40 and 41 under 35 U.S.C. §103(a).

Therefore, the present application, as amended, overcomes the objections and rejections of record and is in condition for allowance. Favorable consideration is respectfully requested. If any unresolved issues remain, it is respectfully requested that the Examiner telephone the undersigned attorney at (703) 519-9952 so that such issues may be resolved as expeditiously as possible.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 504213 and please credit any excess fees to such deposit account.

Respectfully Submitted,

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